



# UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,341	10/09/2001	Pradeep Bahl	211939	6203

23460 7590 11/03/2004

LEYDIG VOIT & MAYER, LTD  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON AVENUE  
CHICAGO, IL 60601-6780

EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,341

Applicant(s)

BAHL, ET AL

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-13,15-23 and 25-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,4-13,15-23 and 25-34 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the step of deprecating, by the mobile host, an old address of the mobile host, the modifying, by the corresponding host, the step of security filters and transport control parameters, and modifying, by the mobile host upon receiving the acknowledgment from the correspondent host as stated claims 1, 12, 33; the step of deprecating includes removing routing entries using the old address from a routing table of the mobile host and the step of adding a tunneling entry based on the old and new addresses in the routing table as stated by claims 2, 13, 34; the modifying security filters and transport control parameters maintained by the corresponding host as stated by claim 22; the step of removing routing entries as stated by claim 23 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### 3. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

#### Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "*Replacement Sheet*" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "*amended*." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

#### Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made is required by the examiner. The annotated drawing sheets must be clearly labeled as "*Annotated Marked-up Drawings*" and accompany the replacement sheets.

#### Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

***Claim Objections***

4. Claims 6, 17, and 27 are objected to because of the following informalities:

All abbreviations, symbols, acronyms, functional designations, sigla, letter combinations, code names, initialisms, nicknames, mnemonic devices, project names, alphabetical contractions and general slang must be positively defined and identified in the claims.

Appropriate correction is required.

***Allowable Subject Matter***

5. Claims 1, 2, 4-13, 15-23, and 25-34 are allowed.
6. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Response to Amendment***

**7. Elimination of Post Office Box in Arlington, Virginia for Patent Related Correspondence**

Effective immediately, the Office will cease accepting patent-related correspondence addressed to the P.O. Box 2327 Arlington, VA 22202. Effective May 1, 2003, pursuant to 37 CFR 1.1, patent-related correspondence should have been addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. Accordingly, as of May 1, 2003, the provisions of 37 CFR 1.8 (Certificate of Mailing) and 1.10 (Express Mail certificate) that were waived by the Office were no longer waived for correspondence addressed to P.O. Box 2327, Arlington, VA 22202.

In November of 2001, the Office established a Post Office Box in Arlington, Virginia (P.O. Box 2327, Arlington, VA 22202) for use on an emergency basis, and indicated that the Office would continue to accept patent-related correspondence at this Arlington, Virginia Post Office Box and treat such correspondence as if it were addressed as set forth in 37 CFR 1.1 for purposes of 37 CFR 1.8 and 1.10 until further notice. On March 25, 2003, the Office provided notice that persons submitting correspondence to the Office should no longer use the Arlington, Virginia Post Office Box for any correspondence (including sequence listings in electronic format) after May 1, 2003. See Correspondence with the United States Patent and Trademark Office, 68 Fed. Reg. 14332 (March 25, 2003).

Correspondence in patent-related matters to organizations reporting to the Commissioner for Patents must be addressed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Appropriate mail stops should also be used. See the notice titled "Special Mail Stops For Patent Mail" that is published each week in the Official Gazette Notices and posted on the USPTO Internet web site.

Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at 800-786-9199 or 703-308-4357. OG Notices: 29 June 2004

**8. New Address for Customer Window Which is Used for Patent Mail Not Delivered by the USPS**

Effective June 5, 2004, street addresses for several of the buildings of the United States Patent and Trademark Office (USPTO), including the Crystal Plaza Two building which is the location of the Customer Window, have been changed. The Customer Window is the delivery location for patent-related correspondence to be hand or courier delivered to the USPTO by delivery services such as FedEx, UPS, DHL, Laser, Action, Purolator, etc. The customer window is not used for correspondence delivered by the United States Postal Service (USPS). This change is made because the street on which the Crystal Plaza Two building is located will be redesignated from South Clark Place to 20th Street S.

Patent-related correspondence sent through the USPS should continue to be directed to the addresses set forth in 37 CFR 1.1 (revised effective January 21, 2004) (e.g., P.O. Box 1450, Alexandria, VA 22313-1450). The change in the street address for the Crystal Plaza Two building which houses the Customer Window does not affect the Mail Stop designations, which should always be used for certain patent mail.

Although the physical location of the Customer Window (the building and room number) will remain the same, on June 5, 2004 the street address of the Crystal Plaza Two building will change from 2011 South Clark Place to 220 20th Street S. Accordingly, effective June 5, 2004, patent mail delivered by hand or delivery services to the Customer Window (and not the USPS) must be addressed as follows:

U.S. Patent and Trademark Office  
220 20th Street S.  
Customer Window, Mail Stop \_\_\_\_\_  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

During business hours, correspondence for international patent applications may be brought directly to the PCT Operations Receptionist on the 8th floor of the Crystal Plaza 2 building.

Also effective June 5, 2004, will be changes in the street addresses of three other USPTO buildings in the Crystal City complex. The street address changes are as follows: the Crystal Plaza Three building will be 2100 Crystal Drive; the Crystal Plaza Four building will be 2200 Crystal Drive; and the Crystal Square Two building will be 1550 Crystal Drive. These changes should be noted in case interviews with examiners in those buildings will be held after June 5, 2004.

Please be aware that the new address for the Customer Window is only temporary. In August or September of 2004, the Customer Window will be moving to the Alexandria campus. At that time, the address for patent mail delivered by hand or delivery services to the Customer Window (and not the USPS) will be changed yet again to a new Customer Window located on the Alexandria campus. A separate notice will be published in advance of the Customer Window relocation announcing specific details. The Customer Window location change planned for August or September will also have no effect on the USPTO address for mail delivered by the USPS.

The File Information Unit (also known as the Record Room) is scheduled

to move to South Tower in July of 2004.

PCT Operations will be moving to South Tower in November or December of 2004. A separate notice will be published in advance of the PCT Operations relocation announcing specific details.

Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center (formerly the Patent Assistance Center (PAC)) by telephone at (800)786-9199, or (703)308-4357. OG Notices: 01 June 2004

#### 9. Patent Application Publications May Now Include Amendments

As a consequence of the use of Image File Wrappers (IFW), the United States Patent and Trademark Office (Office) has begun to publish patent applications with amendments that expedite the publication process. For example, the patent application publication may be based upon amendments to the specification that are reflected in a substitute specification, an amendment to the abstract, amendments to the claims that are reflected in a complete claim listing, and amendments to the drawings that are reflected in replacement drawing sheets, provided that such substitute specification or amendment is submitted in sufficient time to be entered into the application file wrapper before technical preparations for publication of the application have begun. Technical preparations for publication of an application generally begin between fourteen and nine weeks prior to the projected date of publication (the projected publication date is indicated on the filing receipt for the patent application). Accordingly, the provisions 37 CFR 1.215(a) are waived to the extent that they are inconsistent with this change in practice. 37 CFR 1.215(a) will be revised consistent with this change in practice, when the rule changes proposed in Changes To Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan, 68 Fed. Reg. 53816 (Sept. 12, 2003), 1275 Off. Gaz. Pat. Office Notices 23 (Oct 7, 2003) are made final.

Although the Office has begun to include amendments in patent application publications, applicants desiring to ensure that a patent application publication reflects an amendment should submit the application, as amended, through the Electronic Filing System (EFS). See 37 CFR 1.215(c). See also Helpful Hints Regarding Publication of Patent Applications, 1249 Off. Gaz. Pat. Office Notices 83 (August 21, 2001). In addition, if the application is not maintained in an IFW, and the amended application is



not submitted through EFS, a petition under 37 CFR 1.182 will continue to be necessary for certain drawings to be included in the patent application publication. See Manual of Patent Examining Procedure, Section 507 (8th ed. 2001, rev. 1, Feb. 2003).

General questions regarding publication of patent applications should be directed to the Customer Service Center, Office of Patent Publication, by telephone at (703) 305-8283. Questions regarding the Electronic Filing System should be directed to (703) 305-3028. Questions of a legal nature should be directed to the Office of Patent Legal Administration at (703) 308-6906. OG Notices: 13 April 2004

#### 10. Oversized Postcards Must Be Submitted With Sufficient Postage

Recently, a number of return receipt postcards have been returned to the U.S. Patent and Trademark Office (Office) because the postcards contained insufficient postage for an oversized postcard. Oversized postcards require First-Class letter postage. Customers are reminded that they are solely responsible for placing the proper postage on self-addressed postcards that are submitted to the Office for the purpose of obtaining a receipt for correspondence being filed in the Office.

Customers should be aware of the following guidance from the USPS regarding postage and acceptability for postcards:

1. In order to be eligible for the First-Class Mail card rates (currently \$0.23 per card, domestic delivery), cards must be of uniform thickness and made of unfolded and uncreased paper or card stock of approximately the quality and weight of a Postal Service stamped card. Cards claimed at the First-Class postcard rate must be:

- (a) Rectangular;
- (b) No less than 3-1/2 inches high, 5 inches long, and 0.007 inch thick; and
- (c) No more than 4-1/4 inches high, 6 inches long, and 0.016 inch thick.

2. Cards that measure more than 4-1/4 inches high, 6 inches long, or 0.016 inch thick are charged postage at the First-Class Mail letter rates.

3. Cards that measure less than 3-1/2 inches high, 5 inches long, and 0.007 inch thick are nonmailable.

Any return receipt postcard that does not contain sufficient postage or is not acceptable may not be delivered by the United States Postal Service (USPS) to the address provided on the postcard, and, if returned to the Office, may be discarded.

For information regarding the Office's postcard receipt practice in patent-related matters, see Manual of Patent Examining Procedure (MPEP) (8th Ed., Rev. 1, Feb. 2003), Section 503. Questions regarding sufficient postage for postcards should be directed to the United States Postal Service. Questions regarding this notice may be e-mailed to PatentPractice@uspto.gov, or directed to the Inventors' Assistance Center by telephone at (800)786-9199, or (703)308-4357. OG Notices: 29 June 2004

#### 11. SPECIAL MAIL STOPS FOR PATENT MAIL

Revisions have been made to the list of mail stops. The mail stops that **should no longer be used** are: Mail Stop Application Number, Mail Stop CPA, Mail Stop Design, Mail Stop Non-Fee Amendment, Mail Stop PGPUB-ABD, Mail Stop Patent Application, and Mail Stop Provisional Patent Application. Mail Stop Non-Fee Amendment has been changed to Mail Stop Amendment. In addition, Mail Stop PGPUB-ABD has been changed to Mail Stop Express Abandonment and all requests and petitions for an express abandonment under 37 CFR 1.138 should be directed to Mail Stop Express Abandonment or transmitted by facsimile to 703-305-8568. Lastly, Mail Stop L&R and Mail Stop Post Issue have been established.

For most correspondence (e.g., new patent applications) no mail stop is required because the processing of the correspondence is routine. **If NO mail stop is included on the list below, then NO mail stop is required for the correspondence.** Special mail stop designations should only be used for particular types of mail that may be forwarded to the appropriate area without being opened, or that may be processed with the remaining mail. Only the specified type of document should be placed in an envelope addressed to one of these special mail stops. If any documents other than the specified type identified for each special mail stop are addressed to that mail stop, they will be significantly delayed in reaching the appropriate area for which they are intended. The mail stop should generally appear as the first line in the address.

Petitions for a foreign filing license may be faxed to: 703-305-7658.

Some correspondence may be submitted electronically. See the Office's Internet Web site <http://www.uspto.gov> for additional information.

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

**Mail Stop \_\_\_\_****Commissioner for Patents****P.O. Box 1450****Alexandria, VA 22313-1450**

Except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address mail to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

**U.S. Patent and Trademark Office****220 20th Street South****Customer Window, Mail Stop \_\_\_\_****Crystal Plaza Two, Lobby, Room 1B03****Arlington, VA 22202**

**Note:** The Customer Window will be moving to the new Alexandria location in August or September of 2004.

**Mail Stop Designations****Explanation**

Mail Stop 12

Contributions to the Examiner Education Program.

Mail Stop 313(c)

Petitions under 37 CFR 1.313(c) to withdraw a patent application from issue after payment of the issue fee and any papers associated with the petition, including papers necessary for a continuing application or a request for continued examination (RCE).

Mail Stop AF

Amendments and other responses after final rejection, other than an appeal brief.

Mail Stop Amendment

Information disclosure statements, drawings, and replies to Office actions in patent applications with or without an amendment to the application or a terminal disclaimer. (Use Mail Stop AF for replies after final rejection.).

Mail Stop Appeal Brief-  
Patents

For appeal briefs under 37 CFR 1.192 or reply briefs under 37 CFR 1.193(a).

Mail Stop Comments-  
Patents

Public comments regarding patent related regulations and procedures.

Mail Stop Conversion

Requests under 37 CFR 1.53(c)(2) to convert a

	nonprovisional application to a provisional application and requests under 37 CFR 1.53(c)(3) to convert a provisional application to a nonprovisional application.
Mail Stop DD	Disclosure Documents or materials related to the Disclosure Document Program. (A disclosure document is NOT an information disclosure statement.) Instead of filing a disclosure document, inventors are encouraged to file a provisional patent application.
Mail Stop EBC	Mail for the Electronic Business Center including: Certificate Action Forms, Request for Customer Numbers, and Requests for Customer Number Data Change (USPTO Forms PTO-2042, PTO/SB/124A and 125A, respectively) and Customer Number Upload Spreadsheets and Cover Letters.
Mail Stop Expedited Design	Only to be used for the initial filing of design applications accompanied by a request for expedited examination under 37 CFR 1.155. (Design applicants seeking expedited examination may alternatively file a design application and corresponding request under 37 CFR 1.155 by hand-delivering the application papers and request directly to the Design Group Director's office.)
Mail Stop Express Abandonment	Requests for abandonment of a patent application pursuant to 37 CFR 1.138, including any petitions under 37 CFR 1.138(c) to expressly abandon an application to avoid publication of the application. (This new mail stop should be used instead of Mail Stop PGPUB- ABD. Applicants are encouraged to transmit the requests by facsimile to (703) 305-8568.))
Mail Stop ILS	Correspondence relating to international patent classification, exchanges and standards.

Mail Stop Issue Fee	All communications following the receipt of a PTOL-85, "Notice of Allowance and Fee(s) Due," and prior to the issuance of a patent should be addressed to Mail Stop Issue Fee, unless advised to the contrary. Assignments are the exception. Assignments (with cover sheets) should be faxed to 703-306-5995, electronically submitted, or submitted in a separate envelope and be sent to Mail Stop Assignment Recordation Services, Director - U.S. Patent and Trademark Office as shown below.
Mail Stop L&R	All documents pertaining to applications subject secrecy order pursuant to 35 U.S.C. 181, or are national-security classified and required to be processed accordingly. Such papers may also be hand carried to: Technology Center 3600, Office of the Director 2451 Crystal Drive, Room 3D07 Arlington, VA 22202
Mail Stop Missing Parts	Requests for a corrected filing receipt and replies to OIPE notices such as the Notice of Omitted Items, Notice to File Corrected Application Papers, Notice of Incomplete Application, Notice to Comply with Nucleotide Sequence Requirements, and Notice to File Missing Parts of Application, and associated papers and fees.
Mail Stop MPEP	Submissions concerning the Manual of Patent Examining Procedure.
Mail Stop Patent Ext.	Applications for patent term extension and any communications relating thereto.
Mail Stop PCT	Mail related to applications filed under the Patent Cooperation Treaty.
Mail Stop Petition	Petitions to be decided by the Office of Petitions including petitions to revive and petitions to accept late payment of issue fees or maintenance fees.
Mail Stop PGPUB	Correspondence regarding publication of patent applications not otherwise provided, including requests for early publication made after filing, rescission of non-publication request, corrected patent application publication, refund of publication fee.

Mail Stop Post Issue	In patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501. Designation of, or changes to, a fee address should be addressed to Mail Stop M Correspondence. Requests for Certificate of Correction need no special mail stop, but should be made to the attention of Certificate of Correction Branch.
Mail Stop RCE	Requests for continued examination under 37 CFR 1.114.
Mail Stop Reconstruction	Correspondence pertaining to the reconstruction of lost patent files.
Mail Stop <i>Ex Parte</i> Reexam	Requests for Reexamination for original request papers <b>only</b> .
Mail Stop <i>Inter Partes</i> Reexam	Requests for <i>Inter Partes</i> Reexamination for <i>original</i> request papers <b>and</b> for all <i>subsequent</i> correspondence other than correspondence to the Office of the Solicitor (see 37 CFR §§ 1.1(a)(3) and 1.302(c)).
Mail Stop Reissue	All new and continuing reissue application filings.
Mail Stop Sequence	Submission of the computer readable form (CRF) for applications with sequence listings, when the CRF is not being filed with the patent application.

**ADDRESS FOR TRADEMARK MAIL**

The box designations previously listed in Trademark Manual of Examining Procedure, Section 305.01 are no longer in use. See Change of Address for Mailing Trademark Correspondence, which is posted on the USPTO Internet web site at:

<http://www.uspto.gov/web/trademarks/tmmailingaddressnotice.htm>. Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

**12. SPECIAL MAIL STOPS APPLICABLE TO BOTH PATENT AND TRADEMARK MAIL**

The following special mail stop designations are applicable to both patent and trademark related mail, and the recommendations for "Special Mail Stops for Patent Mail" (above) should be followed for the types of mail listed below.

Please address mail to be directed to a mail stop identified below to be delivered by the United States Postal Service (USPS) as follows (unless otherwise instructed):

Mail Stop \_\_\_\_\_  
Director of the US Patent and Trademark Office  
PO Box 1450  
Alexandria, VA 22313-1450

Mail Stop Designations	Explanation
Mail Stop 3	Mail for the Office of Personnel from NFC
Mail Stop 6	Mail for the Office of Procurement.
Mail Stop 8	All papers for the Office of the Solicitor except communications relating to pending litigation and disciplinary proceedings; papers relating to pending litigation in court cases shall be mailed only to Office of the Solicitor, PO Box 15667, Arlington, VA 22215 and papers related to pending disciplinary proceedings before the Administrative Law Judge or the Director shall be mailed only to the Office of the Solicitor, PO Box 16116, Arlington, VA 22215.
Mail Stop 11	Mail for the Electronic Ordering Service (EOS).
Mail Stop 13	Mail for the Employee and Labor Relations Division.
Mail Stop 16	Mail related to refund requests, other than requests for refund of a patent application publication fee. Such requests should be directed to Mail Stop PGPub.
Mail Stop 17	Invoices directed to the Office of Finance.
Mail Stop 24	Mail for the Inventor's Assistance Program, including complaints about Invention Promoters.
Mail Stop 171	Vacancy Announcement Applications.
Mail Stop Assignment Recordation Services	All assignment documents, security interests, and other documents to be recorded in the Assignment records. Note that documents with cover sheets faxed to 703-306-5995 are processed much more quickly than those submitted by mail.

Mail Stop Congressional Relations	Mail for the Office of Congressional Relations.
Mail Stop Document Services	All requests for certified or uncertified copies of patent or trademark documents.
Mail Stop EEO	Mail for the Office of Civil Rights.
Mail Stop Enforcement	Mail for the Office of Enforcement.
Mail Stop Interference	Communications relating to interferences and applications and patents involved in interference.
Mail Stop International Relations	Mail for the Office of International Relations.
Mail Stop M Correspondence	Mail to designate or change a fee address, or other correspondence related to maintenance fees, except payments of maintenance fees in patents. See below for the address for maintenance fee payments.
Mail Stop OED	Mail for the Office of Enrollment and Discipline.

#### **Maintenance Fee Payments**

Payments\* of maintenance fees in patents not submitted electronically over the Internet at [www.uspto.gov](http://www.uspto.gov) should be mailed to:

United States Patent and Trademark Office  
PO Box 371611  
Pittsburgh, PA 15250-1611

#### **Deposit Account Replenishments**

To send payment\* to replenish deposit accounts, send the payments to:  
Director of the United States Patent and Trademark Office  
PO Box 70541  
Chicago, IL 60673

\* Payment of maintenance fees in patents (Attn: Maintenance Fee) and deposit account replenishment (Attn: Deposit Accounts) using hand-delivery and delivery by private courier may be made to:

Director of the United States Patent and Trademark Office

Attn: \_\_\_\_\_

One Crystal Park  
2011 Crystal Drive, Suite 307  
Arlington, Virginia 22202.

Questions regarding the information provided on this page should be directed to: Darnell Jayne, Legal Advisor in the Office of Patent Legal Administration, by telephone at (703) 308-6906 or by e-mail addressed to [PatentPractice@uspto.gov](mailto:PatentPractice@uspto.gov).



### **Conclusion**

13. This application is in condition for allowance except for the above formal matters.

14. Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

15. A shortened statutory period for reply to this action is set to expire **TWO** MONTHS from the mailing date of this letter.

**16. Replacement Notice: Copies of Patent Application Records will be Provided in both Electronic and Paper Form**

The Official Gazette notice, published on August 24, 2004 entitled "*All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form*" (1285 Off. Gaz. Pat. Off, August 24, 2004) is hereby rescinded. The USPTO is reinstating, until further notice, the procedures in effect prior to July 30, 2004 for providing certified copies of patent application records with paper certification statements. The USPTO will also offer electronic certified copies of patent application records at the requester's option.

#### **Certified Copies with Paper Certification**

Unless otherwise requested, certified copies of patent application records provided pursuant to 37 CFR 1.19 (b) will be produced with a paper certification statement, continuing the practice in effect prior to July 30, 2004. The certification statement will include an embossed seal and original signature.

#### **Certified Copies with Electronic Certification**

Customers ordering certified copies of patent applications as filed or patent-related file wrapper and contents of published applications from the USPTO website will have the option to choose electronic copies with electronic certification. These files include an imaged certification statement as part of a PDF file containing the document TIFF images. These electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. Customers may choose to download these electronic files from the USPTO website or receive them on compact disc.

**Paris Convention for the Protection of Industrial Property and Priority**

Irrespective of whether the USPTO provides a paper certified copy or an electronic certified copy, Article 4(d)(3) of the Paris Convention prohibits any country that is a member of the convention from requiring further authentication of the certified copy for purposes of claiming priority under the Paris Convention. (The text of the Paris Convention and a list of its members are available at [www.wipo.int/treaties/en/ip/paris/index.html](http://www.wipo.int/treaties/en/ip/paris/index.html).)

The USPTO is working with other intellectual property offices to encourage the acceptance of priority documents in electronic form with electronic certification. A list of offices and international intellectual property organizations that have agreed to accept electronic certified copies will be posted on the USPTO website soon, and updated regularly.

Questions should be directed to the Office of Public Records by email to [opr@uspto.gov](mailto:opr@uspto.gov) or by telephone at (703) 308-9743.

**17. USPTO to Provide Electronic Access to Cited U.S. Patent References with Office Actions and Cease Supplying Paper Copies**

**Summary**

In support of its 21st Century Strategic Plan goal of increased patent e-Government, beginning in June 2004, the United States Patent and Trademark Office (Office or USPTO) will begin the phase-in of its E-Patent Reference program and hence will: (1) provide downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions via the E-Patent Reference feature of the Office's Patent Application Information Retrieval (PAIR) system; and (2) cease mailing paper copies of U.S. patents and U.S. patent application publications with office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty (PCT). In order to use the new E-Patent Reference feature applicants must: (1) obtain a digital certificate and software from the Office; (2) obtain a customer number from the Office; and (3) properly associate patent applications with the customer number. Alternatively, copies of all U.S. patents and U.S. patent application publications can be accessed without a digital certificate from the USPTO web site, from the USPTO Office of Public Records, and from commercial sources. The Office will continue the practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of cited references will continue to be provided by the USPTO for international applications under the PCT during the international stage.

### Deployment of E-Patent Reference System

The USPTO will deploy the full E-Patent Reference program starting in June of 2004. In accordance with the schedule shown below, paper copies of cited U.S. patents and U.S. patent application publications will cease to be mailed to applicants with Office actions in the indicated Technology Centers (TCs). Paper copies of foreign patents and non-patent literature will continue to be included with office actions.

#### Schedule

June 2004	TCs 1600, 1700, 2800 and 2900
July 2004	TCs 3600 and 3700
<b><u>August 2004</u></b>	<b><u>TCs 2100 and 2600</u></b>

### Description of E-Patent Reference System

On December 1, 2003, the Office made available a new feature in the Office's Private PAIR system, E-Patent Reference, to allow convenient downloading and printing of cited U.S. patents and U.S. patent application publications. A notice announcing this system was published in the Official Gazette, (see Notice of Office Plan to Cease Supplying Copies of Cited U.S. Patent References With Office Actions, and Pilot to Evaluate The Alternative of Providing Electronic Access to Such U.S. Patent References, 1277 Off. Gaz. Pat. Office 156 (Dec. 23, 2003)). The same notice also announced the Office's future plan to cease supplying copies of cited U.S. patents and patent application publications with Office actions.

The E-Patent Reference system allows an authorized user of Private PAIR to download the U.S. patents and U.S. patent application publications cited on a form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants as part of an information disclosure statement (IDS) on form PTO/SB/08 (1449). The retrieval of some or all of the documents is performed in one downloading step with each of the documents encoded as Adobe Portable Document format (.pdf) files.

The E-Patent Reference system was used by applicants during a pilot program in December 2003 and January 2004. In response to some

technical issues discovered by users, changes to make the system more compatible with users' firewalls and office systems were made during the pilot.

Consequently, applicants should expect to start receiving Office actions (in patent applications and during patent reexamination proceedings) without paper copies of cited U.S. patents and U.S. patent application publications in accordance with the schedule above. These documents will be available through the E-Patent Reference system for downloading using Private PAIR. Foreign patents and non-patent literature will continue to be provided to the applicant on paper. Communications from the Office during the international stage of an international application under the PCT will continue to include paper copies of all references, including U.S. patents and U.S. patent application publications.

In summary, all U.S. patents and patent application publications are available on the USPTO web site, from the Office of Public Records and from commercial sources. Additionally, a simple system for downloading the cited U.S. patents and patent application publications has been established for applicants, called the E-Patent Reference system. As E-Patent Reference and Private PAIR require participating applicants to have a customer number, retrieval software and a digital certificate, all applicants are strongly encouraged to contact the Patent Electronic Business Center to acquire these items. To be ready to use this system by June 1, 2004, contact the Patent EBC as soon as possible.

#### Steps to Use the E-Patent Reference Feature

Access to Private PAIR is required to utilize E-Patent Reference. If you do not already have access to Private PAIR, the Office urges practitioners and applicants not represented by a practitioner to: (1) obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate; (2) obtain a USPTO customer number; (3) associate all of their pending and new application filings with their customer number; (4) install free software (supplied by the Office) required to access Private PAIR and the E-Patent Reference; and (5) make appropriate arrangements for Internet access.

#### Instructions for performing the 5 steps:

Step 1: Full instructions for obtaining a PKI digital certificate are available at the Office's Electronic

Business Center (EBC) web page at:

<<http://www.uspto.gov/ebc/downloads.html>>. Note that a notarized signature will be required to obtain a digital certificate.

Step 2: To get a Customer Number, download and complete the Customer Number Request form, PTO-SB/125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Patent Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or agent, then your registration number must be associated with your customer number. This association is accomplished by adding your registration number to the Customer Number Request form.

Step 3: A description of associating a customer number with the correspondence address of an application is described at the EBC Web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

Step 4: The software for electronic filing is available for downloading at [www.uspto.gov/ebc](http://www.uspto.gov/ebc). Users can also contact the EFS Help Desk at (703) 305-3028 and request a copy of the software on compact disc. Users will also need Adobe Acrobat Reader, which is available through a link from the USPTO web site.

Step 5: Internet access will be required which applicants may obtain through a supplier of their own choice. As images of large documents must be downloaded, high-speed Internet access is recommended.

The E-Patent Reference feature is accessed using a button on the Private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents in the Portable Document Format (.pdf). The downloaded documents can be viewed and printed using Adobe's Acrobat Reader program and other software.

Other Options

The E-Patent Reference function requires the applicant to use the secure Private PAIR system, which establishes confidential communications with the applicant. Applicants using this facility must receive a digital certificate, as described above. Other options for obtaining patents which do not require the digital certificate include the USPTO's free Patents on the Web program (<http://www.uspto.gov/patft/index.html>). The USPTO's Office of Public Records also supplies copies of patents and patent application publications for a fee (<http://ebiz1.uspto.gov/oems25p/index.html>). Commercial sources also provide patents and patent application publications.

Section 707.05(a) of the Manual of Patent Examining Procedure, which currently provides that copies of cited references are in general automatically furnished without charge to applicant together with the Office action in which they are cited, will be revised in due course for consistency with the practice announced in this notice.

#### Comments

The Office published a notice announcing its plan to cease supplying copies of cited U.S. patent references with Office actions, (see Notice of Office Plan to Cease Supplying Copies of Cited U.S. Patent References With Office Actions, and Pilot to Evaluate The Alternative of Providing Electronic Access to Such U.S. Patent References, 1277 Off. Gaz. Pat. Office 156 (Dec. 23, 2003)). The Office received numerous comments in response to this notice. A summary of representative comments and the Office's responses to the comment, grouped by topics, follows:

Comment 1: The requirement to use the Office's customer number/digital certificate shifts the responsibility of producing paper copies to the applicant. A number of comments indicated that adopting the proposal would result in an increased responsibility for the applicant, as the applicant or applicant's representative would be required to print the references.

Response: The USPTO is implementing the E-Patent Reference program as part of the Office's e-Government initiative and to align funding priorities to the Patent Initiatives, including the hiring of examiners. Applicants can purchase copies of U.S. patents and patent application publications from a variety of vendors if they choose not to print copies through the E-Patent Reference system.

The USPTO is moving toward electronic filing and processing of both patent applications and trademark applications. The policy announced in this notice is simply a step towards a more fully automated patent examination process. By analogy, briefs and court opinions that include case citations do not include paper copies of the cited cases. Rather, the cited cases are available via books or electronic databases. Similarly, the USPTO will no longer provide paper copies of U.S. patents and patent application publications since they are available electronically free of charge. Finally, this change will avoid duplication and waste since an applicant may not need to print out every page of a cited U.S. patent or patent application publication.

Comment 2: Adopting the proposal would hurt the solo practitioners and pro se applicants the most, which is unfair.

Response: The solo practitioners and pro se applicants have the same electronic access as the larger firms and corporations, available instantaneously over the Internet. If a solo practitioner or a pro se applicant chooses not to print copies of U.S. patents and patent applications publications through the USPTO Patents on the Web system or through the E-Patent Reference system, commercial sources that provide patents very quickly and inexpensively are available, and copies of U.S. patents and patent application publications are also available at the Patent and Trademark Depository Libraries (PTDLs). Additionally, the cost of patents if ordered from the USPTO Office of Public Records is very reasonable (\$3).

Comment 3: Some applicants indicated that the service is reliable and quick, and consistent with the electronic commerce initiatives in their law firms and businesses.

Response: As pointed out by some respondents, electronic copies of the references are very usable, available without mail delays, and capable of being sent to clients, other attorneys and experts by electronic means.

Comment 4: The statute 35 USC Sec. 132 requires the Office when sending a rejection to state the reasons "together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application".

Response: The requirement that an Office action

contain "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application" was added to the patent laws in the Patent Act of 1870. The circumstances surrounding this provision reveal that it requires that an Office action identify the prior inventions or patents that are relied upon in making a rejection, not that it requires that an Office action be accompanied by copies of the cited references. The USPTO did not even begin providing copies of cited references with Office actions until 1965, when 35 U.S.C. Sec. 41 was amended to authorize (but not require) the USPTO to provide copies of patents cited in Office actions without charge. See 35 U.S.C. Sec. 41(e) ("[t]he Director may provide any applicant issued a notice under [35 U.S.C. Sec. 132] with a copy of the specifications and drawings for all patents referred to in that notice without charge") (emphasis added). Nevertheless, the Office will provide access to U.S. patents and patent application publications, albeit not in paper form.

Comment 5: A number of users suggested that the Office provide paper references at an extra cost.

Response: The Office of Public Records does offer that service, at a reasonable cost, and it is available through a number of delivery channels. See 37 CFR 1.19 (a). Commercial services also provide U.S. reference documents, in person, by mail, and over the Internet.

Comment 6: Some comments indicated that the length of the pilot should have been expanded.

Response: E-Patent Reference system will continue through the end of May to allow applicants to become familiar with E-Patent Reference and to be sure all technical concerns are addressed.

#### For Further Information Contact

Questions concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the Patent EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov). Questions about this notice may be directed to Jay Lucas, at [Jay.Lucas@uspto.gov](mailto:Jay.Lucas@uspto.gov) and Rob Clarke, at [Robert.Clarke@uspto.gov](mailto:Robert.Clarke@uspto.gov). **OG**  
**Notices: 18 May 2004**



18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday-Tuesday 10:30am to 8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wdc



UNITED STATES  
PATENT AND  
TRADEMARK OFFICE

  
**WILLIAM CUMMING**  
**PRIMARY EXAMINER**  
**GROUP 2600**

**William Cumming**  
Primary Patent Examiner  
(703) 305-4394  
(703) 746-6075 Fax  
[william.cumming@uspto.gov](mailto:william.cumming@uspto.gov)